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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/233,860 01/20/99 HUTCHINSON

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D C TOEDT
ARNOLD & WHITE & DURKEE
P O BOX 4433
HOUSTON TX 77210

EXAMINER

THOMSON, W

ART UNIT

PAPER NUMBER

2758

DATE MAILED:

11/12/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/233,860

Applicant(s)
Hutchinson et al.

Examiner
William Thomson

Group Art Unit
2758



☒ Responsive to communication(s) filed on Jun 29, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-3, 5-8, 10-13, and 15-23 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-3, 5-8, 10-13, and 15-23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Claims 1-3,5-8, 10-13, 15-20 and 21-23 have been submitted for examination. Claims 1-3,5-8, 10-13, 15-20 and 21-23 have been examined and rejected.

Claim Rejections - 35 U.S.C. § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 15, are rejected under 35 U.S.C. 112, second paragraph, since they recite the limitation "node identifier" in line 3 and line 2, respectively. There is insufficient antecedent basis for this limitation in either claim.

Claims 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are written in a manner that does not distinguish them as either method or computer readable medium, but rather some type of hybrid wherein the computer readable medium cannot be clearly correlated to specific method steps. "A program storage device readable by a processor in the node of a specified one of claims 1 through 3, 5 through 7, and 21 through 23, and encoding a program of instructions including instructions for performing the operations recited in said specified claims" and "A program storage device readable by a

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processor in the server node of a specific one of claims 8 and 10 and encoding a program of instructions including instructions for performing the operations recited in said specified claims” are unclear because a program storage device readable by a processor and encoding a program of instructions for performing the operations cannot be clearly correlated to the method steps. The examiner is left to speculate to the intended meaning of these claims.

3. The following is a quotation of the forth paragraph of 35 U.S.C. 112:

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim shall in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

Claims 11 and 12 are rejected under 35 U.S.C. 112, forth paragraph, for failing to further limit the claim that each depends from. “A program storage device readable by a processor in the node of a specified one of claims 1 through 3, 5 through 7, and 21 through 23, and encoding a program of instructions including instructions for performing the operations recited in said specified claims” and “A program storage device readable by a processor in the server node of a specific one of claims 8 and 10 and encoding a program of instructions including instructions for performing the operations recited in said specified claims” imply the same scope relative to the claims to which each depends. Therefor these dependent claims do not further limit the claims to which each dependent claim refers.

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Claim Rejections - 35 U.S.C. § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1-3,5-8, 10-13 and 15-23 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Chiang et al.

Taking claim 1, for example, Chiang et al. discloses: (Abstract, figures 3-6, col. 6, lines 11 et seq.)

A method, executed by a node (workstation) on a network (200), of transmitting identifying information about the node, the method comprising:

determining a current NIC address value (MAC address);

retrieving from a data storage at the node, a former NIC address value (MAC address) for the node (workstation); and

transmitting the current NIC address value (MAC address) and the former NIC address value (MAC address).

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As to claim 2, the method of claim 1, wherein determining the current node identifier (MAC address) includes an attempt to detect the then current NIC address value (MAC address).
Figures 4-6, col. 8, lines 23 et seq.)

As to claim 3, the method of claim 2, wherein the attempt to detect the current NIC address value is unsuccessful, and further comprising:

retrieving, from a data storage at the node, a stored value containing the result of the past live detection of the then-current NIC address value (current MAC address) referred to as a previously detected NIC address value (last MAC address); and

transmitting the previously detected NIC address value (last MAC address).

Claim 5 recites providing the NIC address value comprises a signature portion and a pseudo randomly generated portion which is the industry standard for generating the MAC addresses stored within the MAC address pool as disclosed within Chiang et al.

Claim 6 recites the use of redundant storage as disclosed within Chiang et al. (Cache 430 and 425) Chiang et al. discloses the ability to determine which MAC addresses are acceptable and whether the requested or suggested MAC address has been previously assigned at the client.

Claim 7 recites the use of a time stamping to determine the last NIC address assigned as disclosed within Chiang et al. The client determines if the MAC address has been assigned and whether or not to accept a specified MAC address and uses an equivalent method of determining if the MAC address is a former or current address assignment.

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Claims 8, 13, 16-17, 19, 21-23 are rejected for the same reasoning as claims 1-3 and 6-7, set forth above, supra. Claims 8, 13, 16-17, 19, 21-23 contain the same limitations as the equivalent claims 1-3 and 6-7 and disclosed within Chiang et al.

Claims 10, 15, 18 and 20 are rejected for the same reasoning as claim 5, set forth above, supra. Claims 10, 15, 18 and 20 contain the same limitations as recited in claims 10, 15, 18 and 20 and disclosed within Chiang et al.

As for claims 11 and 12 are rejected for the same reasoning as the claims to which they respectively depend, claims 1 through 3, 5 through 7 and 21 through 23 and 8 and 10, respectively, as set forth above, supra. Claims 11 and 12 are interpreted as merely the equivalent computer-readable medium claims containing the same limitations as claims 1 through 3, 5 through 7 and 21 through 23 and 8 and 10, respectively, as disclosed within Chiang et al.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure, careful consideration should be given prior to applicant's response to this Office Action.

U.S. Patent 5,970,066 issued to Lowry et al. discloses a virtual MAC addressing system for clients and servers.

U.S. Patent 5,841,991 issued to Russel discloses an interactive network board including downloading new MAC addresses to the network board from a server.

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U.S. Patents 5,590,285 and 5,535,338 issued to Krause et al. disclose network cards with multiple MAC addresses.

U.S. Patent 5,490,139 issued to Baker et al. discloses mobility enabling access point architecture for wireless attachment to source routing networks.

U.S. Patent 5,958,018 issued to Eng et al. discloses a wireless services data network translating MAC address to ATM address.

U.S. Patent 5,757,924 issued to Friedman et al. discloses a network security device which performs MAC address translations without affecting the IP address.

U.S. Patent 5,894,479 issued to Mohammed discloses providing address resolution information for self registration of clients on power up or dial in.

U.S. Patent 5,774,640 issued to Kurio discloses a method and apparatus for providing a fault tolerant network interface controller for substituting MAC address when a card fails.

U.S. Patent 5,572,528 issued to Shuen discloses a mobile networking method and apparatus.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Thomson whose telephone number is (703) 305-0022. The examiner can be usually reached between 9:30 a.m. - 4:00 p.m. Monday thru Friday. Voice mail is checked throughout the day. Please leave a detailed message.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Ahmad Matar, can be reached on 704-305-4731. The fax phone number for this Group is 703-305-7201.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 703-305-3900.

William D. Thomson

Patent Examiner

A.U. 2758

November 5, 1999



AHMAD F. MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2700